

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 10/659,568
Filing Date September 10, 2003
Inventor Chen et al.
Confirmation No. 4683
Examiner Rutledge, Amelia L.
Group Art Unit 2176
Applicant Microsoft Corporation
Attorney's Docket No. MS1-1524US

Title: Annotation Management in a Pen-Based Computing System

REQUEST TO RESCIND THE FINALITY
OF THE PREVIOUS OFFICE ACTION

WHICH WAS

DATED (MAILED) 08/07/2006

UNDER 37 CFR § 1.116

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REQUEST

The first sentence of the second paragraph of M.P.E.P. 706.07(a) reads as follows:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is respectfully submitted that the new ground of rejection introduced in the previous (and currently labeled "Final") Office Action was not necessitated by Applicants' amendment.

A careful review of the amendment(s) to claim 1 reveals that amended claim 1 is merely former dependent claim 5. Similarly, claim 14 was amended to be substantively identical to former dependent claim 15.

In other words, the subject matters of these claims were previously present in the Patent Application and the grounds of rejection applied thereto were nevertheless changed by the Office.

Accordingly, it is respectfully submitted that the finality was inappropriate. Withdrawal of the finality of the 08/07/2006 Office Action is therefore requested under M.P.E.P. 706.07(c) and (d).

CONCLUSION

Because of the premature nature of the asserted Final Rejection, withdrawal of the finality of the previous Office Action (dated 08/07/2006) is hereby requested.

Respectfully Submitted,

Date: 10/5/2006

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